

REMARKS

In the Office action dated September 10, 2003, claim 53 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 10, and 12-14 of U.S. Patent No. 6,139,527. Claims 68, 72-74, and 77-82 were rejected under 35 U.S.C. 112, second paragraph. Claims 34, 36, 38-40, 43, 48-50, 52, 53, 55, 60, 61, 65, 66, 83 and 84 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,709,224 ("Behl") in view of U.S. Patent No. 5,885,278 ("Fleischman"). The drawings were also objected to in view of claims 51, 67, and 82.

Claims 41, 42, 51, 67, and 79-82 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. The Office action also stated that claims 68, 72-74, and 77-82 would be allowable if rewritten or amended to overcome the 35 U.S.C. 112 rejection.

By the present amendment, claim 68, 78 and 79 have been amended. Claims 34, 36, 38-43, 48-53, 55, 60-61, 65-68, 72-74, and 77-84 are pending and under consideration in the present application. Claims 35, 37, 44-47, 54, 56-59, 62-64, 69-71, 75, and 76 were withdrawn from consideration as being drawn to an unelected species. Applicant respectfully requests reconsideration of the present application.

DRAWINGS

The drawings were objected to because “the ultrasonographic imaging apparatus set forth in the claims 51, 67, and 82” was not shown in the drawings. Submitted herewith is a proposed drawing correction to add Figure 8A in reply to this objection. New formal drawings will be submitted if the proposed new drawing is approved.

OBVIOUSNESS-TYPE DOUBLE PATENTING

Claim 53 was rejected under the judicially created doctrine of obviousness-type double patenting. Should this claim be found to be otherwise allowable, a terminal disclaimer may be submitted to obviate this rejection.

SECTION 112 REJECTION

The Office action asserted that claims 68, 72-74, and 77-82 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite because there is no antecedent basis for “the catheter shaft” in claim 68. Claims 68, 78 and 79 have been amended to delete the word “shaft.” Applicant respectfully requests that the Section 112 rejection be withdrawn.

SECTION 103 REJECTION

Claims 34, 36, 38-40, 43, 48-50, 52, 53, 55, 60, 61, 65, 66, 83 and 84 were rejected under Section 103(a) as being unpatentable over Behl in view of Fleischman.

Applicant respectfully submits that neither Behl nor Fleischman disclose or suggest the claimed invention.

By way of example, claim 34 recites that "the electrodes are spaced apart from one another by less than 180 degrees," and claim 53 recites that the directional energy application apparatus delivers energy to "a circumferential portion of the vein and not the entire circumference of the vein."

Fleischman is directed to ablating myocardial tissue to interrupt potential electrical pathways in the heart (and restore normal function to the heart), whereas Behl is directed to occluding blood vessels (and prevent the blood vessels from functioning).

The Office action states that "Fleischman is moot to cause preferential shrinkage," but that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Behl's energy ranges with Fleischman's ablation catheter to cause preferential shrinkage of a vein, since Behl suggest that RF energy can be applied to a vein or other body lumens." *See* page 4 of Office action. The Office action later states on pages 6-7, that:

In this case, the suggestion to combine the references is that both references are ablation catheters either one with different intended use. However, Behl teaches preferential shrinkage of the vein. Therefore it would have been obvious to use Fleischman's catheter with Behl's energy ranges to cause preferential shrinkage of the vein.

Applicant respectfully submits that there is no proper motivation to modify the references, and that the conclusion set forth in the Office action is based on

impermissible hindsight. Moreover, Behl does not teach preferential shrinkage of the vein (instead, as previously discussed, Behl is directed to occluding blood vessels).

As set forth in MPEP 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, "including portions that would lead away from the claimed invention." *See also Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686 (Fed. Cir. 2004) ("This court has provided further assurance of an 'as a whole' assessment of the invention under §103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination.").

Here, Behl is directed to occluding blood vessels to prevent the blood vessels from functioning, while Fleischman is directed to ablating myocardial tissue to restore normal function to the heart. The teachings of these references lead to different results, and thus teaches away from their combination.

"THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION." MPEP 2143.01; *see also In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998) (there was no support for the conclusion that it would have been obvious to substitute one type of detector for another in the primary reference). The Office action asserts that it would have been obvious to "to use Behl's energy ranges with Fleischman's ablation catheter to cause preferential shrinkage of a vein," but

provides no explanation as to why one would modify Fleischman's ablation catheter for ablating myocardial tissue to perform a different procedure, namely "to cause preferential shrinkage of a vein." Such modification appears to be, if anything, contrary to Fleischman's intended use.

Nonetheless, the Office action states that "the suggestion to combine the references is that both references are ablation catheters either one with different intended use." However, categorizing art as "ablation catheters" does not establish that the references are in the same field of endeavor, let alone provide a proper motivation to combine. "FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS." MPEP 2143.01. Applicant respectfully submits that simply classifying Fleischman and Behl as "ablation catheters" provides no motivation to combine their disparate teachings, especially in view of their different purposes.

"THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE." MPEP 2143.01. Modifying Fleischman's ablation catheter to cause occlusion of a lumen as taught in Behl, as asserted in the Office action, would render Fleischman unsatisfactory for its intended purpose of ablating myocardial tissue to interrupt potential electrical pathways in the heart and restore normal function to the heart. If anything, it would prevent the heart from functioning, which would be an unsatisfactory result.

No proper motivation has been provided for one of ordinary skill to combine the teachings of prior art directed to such different problems in the manner alleged in the

Office action. Applicant respectfully submits that the Section 103 rejection of the claims be withdrawn as well.

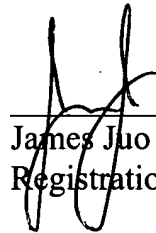
CONCLUSION

Applicant respectfully requests favorable reconsideration of the claims at an early date. Should the claims be allowed in the present application, Applicant further requests that the claims presently withdrawn from consideration as being drawn to an unelected species be considered and allowed as well, to the extent that they depend from an allowed claim. If the Examiner has any comments or questions regarding any of the foregoing, kindly telephone the undersigned.

Respectfully submitted,

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